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09/863,560	05/23/2001	Mimi C. Dong	10010208-1	9404

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EXAMINER

LE, BRIAN Q

ART UNIT PAPER NUMBER

2624

DATE MAILED: 06/14/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/863,560
Filing Date: May 23, 2001
Appellant(s): DONG, MIMI C.

James L. Baudino (Reg. No. 43,486)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/16/2006 appealing from the Office action mailed 10/20/2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Claims Appealed*

The copy of the appealed claims contained in the Appendix of Claims to the brief is correct.

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(8) Prior Art of Record

6,539,077	Ranalli et al.	03-2003
6,636,620	Hoshino	10-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-9, and 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ranalli et al. U.S Patent No. 6,539,077.

Regarding claim 1, Ranalli discloses a device (system) (abstract) comprising: a connection to a network (Internet-enabled communication) (abstract); and a network address derived from a fingerprint (Ranalli discloses a unique identifier which can be a fingerprint. Network address/Internet address is then provided/derived/generated to associate with the unique identifier of the fingerprint) (column 2, lines 25-50 and column 6, lines 10-25).

Referring to claim 2, Ranalli further discloses the device wherein the network is the Internet and network address is an Internet address (column 2, lines 30-35).

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For claim 4, Ranalli teaches the device further comprising a fingerprint file storing the fingerprint (database to store unique identifier from fingerprint) (column 2, lines 25-30 and column 12, lines 35-38).

Also to claim 5, as explained in claim 4, Ranalli further teaches the device further comprising a fingerprint file storing the network address derived from the fingerprint (column 2, lines 25-30 and column 12, lines 35-38).

For claim 6, please refer back to claim for the teaching and explanation.

For claim 7, Ranalli teaches the system wherein the network address is derived from a fingerprint of an authorized user (user who may be reached) (column 2, lines 25-50 and column 6, lines 10-25).

For claim 8, please refer back to claim 2 for the teaching and explanation.

Regarding claim 9, Ranalli teaches the system wherein the network address is an address of a global network (internet address is global address since every system globally can recognize it) (abstract).

For claims 11-12, please refer back to claims 4-5 respectively for the teaching and explanation.

Referring to claim 13, Ranalli also discloses the system further comprising: a server coupled to the Internet; and at least one appliance coupled to the server (data network/network printer) (column 3 and FIG. 4).

Regarding 14, as well explained in claim 1, Ranalli also teaches a method, comprising: generating a network address derived from a fingerprint; and accessing a system over a network using the derived network address (column 2, lines 25-50 and column 6, lines 10-25).

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For claim 15, Ranalli teaches the method further comprising obtaining a Fingerprint (column 6, lines 20).

For claim 16, please refer back to claims 4-5 for the teaching.

Referring to claim 17, please refer back to claim 1 for the teaching and explanation.

Regarding claim 18, please refer back to claim 13 for the teaching and explanation.

For claim 19, Ranalli further teaches the method, as set forth in claim 14, further comprising generating system authorization based on the fingerprint (system allow the accessibility base on unique identifier of the fingerprint) (column 2, lines 35-39).

3. Claims 1, 3, 6, 10, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoshino U.S. Patent No. 6,636,620.

Regarding claim 1, Hoshino teaches a device (personal identification system) comprising: connection to a network (computer or server); and network address derived from a user's fingerprint (the accessibility to computer which has a network address by authenticating fingerprints) (abstract).

For claims 3 and 10, Hoshino also teaches the device comprising fingerprint scanner (fingerprint sensor) (FIG. 2, element 46).

For claims 6 and 14, please refer back to the teaching and explanation of claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranalli et al. U.S Patent No. 6,539,077.

Regarding claims 3 and 10, Ranalli teaches a scanner (column 11, lines 38-43) but does not explicitly teaches a fingerprint scanner though it does use input fingerprints. The Examiner takes Office Notice that it would have been obvious for one skilled in the art to obtain fingerprint using a fingerprint scanner to scan fingerprint indicia because this is the conventional way to input fingerprints and would be needed to properly use the invention.

(10) Response to Argument

(A) The following discussion relates to the rejection of claims 1, 2, 4-9 and 11-19 are rejected under 35 U.S.C. 102 (e) as being anticipated by Ranalli et al. U.S Patent No. 6,539,077.

Appellant's argument ---- Regarding claim 1, Appellant argues (page 6 of the Appeal Brief) that the "Examiner's assertion that the unique identifier in Ranalli could be a fingerprint is clearly unsupported. Furthermore, the Applicant accused (page 5, second paragraph of the Appeal Brief) the Examiner is rejecting the claim based on the Examiner's own "interjected idea" of what the "unique identifier" of Ranalli could be. The Applicant concluded that the Examiner is looking beyond the Ranalli reference to maintain the 35 U.S.C. 102 rejection, which is improper.

Examiner's response ---- The Examiner respectfully disagree with Appellant's statement. Ranalli clearly teaches this limitation at column 6, lines 10-25 "Examples of unique identifiers that communication systems **might use to identify** a station set, person, place or organization **include, among others:**

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Telephone numbers

Random unique numbers

Personal identity codes

Social Security Numbers

Recorded spoken name

Voice prints

Finger prints (emphasis added)

Retina scans”

Thus, if the Applicant had carefully considered the reference and had read the cited the locations by the Examiner, the Applicant would able to see this before making a false accusation. Clearly, it **is nothing more than the Applicant’s own interjected ideal of what the unique identifier of Ranalli could be**. In this case, the Applicant has continuously **refused to accept** the fact that Ranalli clearly discloses that unique identifier can be fingerprint.

(B) The following discussion relates to the rejection of claims 1, 3, 6, 10-14 are rejected under 35 U.S.C. 102 (e) as being anticipated by Hoshino U.S Patent No. 6,636,620.

Appellant’s argument ---- Appellant argues (page 7, first paragraph of the Appeal Brief) that Hoshino does not disclose a network address is derived from a user’s fingerprint.

Examiner’s response ---- Again, the Examiner respectfully disagrees. As indicated by Hoshino (abstract) that the accessibility from terminal to computer server which has a network address by authenticating fingerprints can clearly be read for this broadly claim limitation

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“network address derived from a user’s fingerprint” since once the fingerprint is authenticated then the communication is allowed by the communication provided/linked to the network address of the computer server. Hoshino further elaborates this network address concept at column 2, lines 31-40.

(C) The following discussion relates to the rejection of claims 3 and 10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ranalli et al. U.S Patent No. 6,539,077.

Appellants’ argument---- Appellant further argues (page 8 of the Appeal Brief) that Ranalli clearly does not disclose a use of a user’s fingerprint and that the “unique identifier” could be a fingerprint is unsupported.

Examiner’s response ---- The Examiner respectfully disagree with Appellant. This argument is clearly discussed and explained by the Examiner at “Response to Argument”, section (A). Thus, the usage of the “unique identifier” clearly is the usage of fingerprint by Ranalli (column 6, lines 10-25).

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted

A handwritten signature in black ink, appearing to read "Brian Le". The signature is fluid and cursive, with a large initial "B" and a long, sweeping tail.

Brian Le

Examiner

March 28, 2006

Appeal Conferees:



Joseph Mancuso

A handwritten signature in black ink, appearing to read "Joseph Mancuso". The signature is cursive and somewhat stylized, with a large initial "J" and a long, sweeping tail.

Jingge Wu

A handwritten signature in black ink, appearing to read "Jingge Wu". The signature is cursive and somewhat stylized, with a large initial "J" and a long, sweeping tail.